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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,960	08/18/2003	Patrick A. Hawkins	558.008US1	4188

21186 7590 11/12/2008
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MINNEAPOLIS, MN 55402

EXAMINER

EPPS, TODD MICHAEL

ART UNIT	PAPER NUMBER
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3632

MAIL DATE	DELIVERY MODE
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11/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/642,960

Applicant(s)

HAWKINS, PATRICK A.

Examiner

Todd M. Epps

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-21, 29 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-21, 29 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is the second Office Action **final** for serial number 10/642,960, Mounting Device, filed on August 18, 2003.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6-21, and 29-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No.

6,679,461 to Hawkins in view of U.S. Patent No. 5,172,097 to Arnold.

Hawkins '461 discloses all of the limitations in the claims except for the plate structure disposed over the side surfaces. Nevertheless, Arnold '097 discloses a cover (30) with lips (31) over the unit (10). Accordingly, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to have included the support device of Hawkins '342 in view of Burgess '089 to include the lips as taught by Arnold '097 because one would have motivated to provide a means for preventing dirt / moisture from running into the interior of the support structure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 9, 11-16, 18, 19, 21, 29, 31-33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,855,342 to Hawkins et al. (Hawkins) in view of U.S. Patent No. 7,102,089 to Burgess et al. (Burgess); and in further view of U.S. Patent No. 5,172,097 to Arnold.

Hawkins '342 discloses a support device adapted to support structures on a rooftop surface (as shown in Figure 5, see col. 5, lines 46-52), the support device (fig. 1) comprising: a support structure (10), wherein the support structure having a top surface, a bottom surface, and side surfaces, and the bottom surface to rest on the rooftop surface, and has a recess therein; wherein the support structure comprises a pliable form material (col. 3, lines 20-33); wherein the plate structure includes metal sheet; at least one elongate coupling member / strut (50) to couple to the structures to be supported on the rooftop surface; and the elongated strut includes a channel shaped

cross section with a bottom strut surface, a first strut side surface, a second strut side surface with a first strut lip extending along the first strut side surface and oriented approximately parallel to the bottom strut surface, a first strut side surface, a second strut lip extending along the second strut side surface and oriented approximately parallel to the bottom strut surface; and wherein the elongate strut has an approximately rectangular cross section, the cross section taken orthogonal to the length of the elongate strut.

However, Hawkins '342 fails to teach a plate structure, wherein at least a portion of the plate structure disposed on the top surface and coupled with the support structure. Nevertheless, Burgess '089 discloses a plate structure (145a); wherein at least portion of the plate structure disposed on the top surface and disposed within the recess; wherein the plate structure is a substantially rigid plate structure, and further comprising a fastener that fasten the plate structure with the support structure. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the support device of Hawkins '342 with a plate structure as taught by Burgess '089 wherein doing so would provide thereof for a better design consideration.

Furthermore, Hawkins '342 in view of Burgess '089 fails to disclose wherein a plate structure disposed onto at least a portion of the side surfaces. Nevertheless, Arnold '097 discloses a cover (30) with lips (31) disposed onto at least a portion of the unit (10). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the support device of Hawkins '342 in view of

Burgess '089 to include the lips as taught by Arnold '097 because one would have motivated to provide a means for preventing dirt / moisture from running into the interior of the support structure.

In regard to claims 12, 13, and 30, Hawkins '342 fails to teach wherein at least one elongate strut is defined by the plate structure. Burgess '089 discloses an elongate strut is defined by the plate structure. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified a strut of Hawkins '342 with the plate as taught by Burgess '089 to formed by surfaces of the plate into one piece to save manufacturing costs. In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

Claims 20, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins '342 in view of Burgess '089, and in further view of U.S. Patent No. 6,888,977 to Wong et al (Wong).

Hawkins '342 in view of Burgess '089 fails to teach wherein the fastener includes adhesive. Nevertheless, Wong '977 discloses a support plate with adhesives underneath as a fastener, and disposed between the support plate and the support structure. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to included the support structure and plate of Hawkins '342 in view of Burgess '089 with the adhesive as taught by Wong '977 wherein doing so would provide thereof for additional strength to hold the plate down.

Claims 8, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins '342 in view of Burgess '089, and in further view of U.S. Patent No. 5,942,347 to Koncar et al. (Koncar).

Hawkins '342 in view of Burgess '089 fails to disclose wherein the plate structure includes plastic and HDPE. Attention is directed to Koncar '347, which teaches a plate made of plastic or HDPE (Col. 7, lines 35-46). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the support device of Hawkins '342 with a plate structure as taught by Burgess '089 and further in view of Koncar '347 with a plate made of plastic or HDPE wherein doing so would provide thereof for stronger support to last longer and a cheaper cost for a manufacturing purpose.

Response to Arguments

Applicant's arguments filed August 14, 2008 have been considered but they are not persuasive.

In response to applicant's argument that Burgess '089 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Burgess '089 discloses a plate structure (145a) is shaped and configured by a

clamping press, wherein at least portion of the plate structure disposed on the top surface (142a) and disposed within the recess.

Further, in response to applicant's argument that Arnold '097 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Arnold '097 discloses a plate structure (30) having side surfaces (31), which fits over the top surface and onto the side surface of a support structure (10),

Next, in response to applicant's argument that Wong '977 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Wong '977 discloses a support plate with adhesives underneath a fastener, and disposed between the support plate and the support structure.

Last, in response to applicant's argument that Koncar '347 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the

claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Koncar '347 discloses a plate made of plastic or HDPE.

Therefore, applicant will see that four nonanalogous arts are properly used in the rejection. All motivations for modification of the four nonanalogous arts can be found in the above rejections.

It is noted that claims 6, and 14 (line 1) with the newly amended claim language, which each recites a support device adapted to support structures on a rooftop surface, it is considered as a functional language and the applicant is not claiming a rooftop surface. Needless, Hawkins '342 discloses a support device installed on a roof of a building. With the motivation listed above, applicant will see that Hawkins '342 with the four prior arts are properly used in the rejection.

Again, a Double Patenting Rejection still stands until a Terminal Disclaimer is submitted.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd M. Epps whose telephone number is (571) 272-8282 – or – whose e-mail address is Todd.Epps@uspto.gov. The examiner can normally be reached on M-F (7:30-4:30).

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T.M.E./

Todd M. Epps
Patent Examiner
Art Unit 3632

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Art Unit: 3632

November 8, 2008

/Alfred Joseph Wujciak III/

Primary Examiner, Art Unit 3632

Application Number**Application/Control No.**

10/642,960

Examiner

Todd M. Epps

**Applicant(s)/Patent under
Reexamination**

HAWKINS, PATRICK A.

Art Unit

3632